

00862.022392



PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
FUMITAKA TOYOMURA, et al.) Examiner: Younghuie Jessica Han
Application No.: 09/963,569) Group Art Unit: 2838
Filed: September 27, 2001)
For: POWER CONVERTING)
APPARATUS AND POWER)
GENERATING APPARATUS) June 10, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT
AND
REQUEST UNDER 37 C.F.R. § 1.705(b) TO RECONSIDER
✓ PATENT TERM ADJUSTMENT

Sir:

Applicants hereby apply for patent term adjustment and request the Commissioner under 37 C.F.R. § 1.705(b) for reconsideration and recalculation of the patent term adjustment (PTA) indicated in the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b), included with the Notice of Allowance and Fee(s) Due issued April 30, 2009. Submitted herewith is a check for \$600.00 to cover the fees required under 37 C.F.R. §§ 1.18(e) and (f). Any deficiency in or overpayment of this fee should also be charged or credited to Deposit Account 06-1205.

06/12/2009 JAD002 00000001 09963569

01 FC:1455
02 FC:1462

200.00 OP
400.00 OP

For the following reasons, it is respectfully submitted that the Determination should indicate a patent term adjustment of 1,421 days.

FACTS

1. On April 30, 2009, a Notice of Allowance and Fee(s) Due (Notice) was issued. Attached to the Notice was a Determination of Patent Term Adjustment Under 35 U.S.C. §154(b), which states that if “the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 405 day(s)”.

2. The Patent Application Information Retrieval system (PAIR) of the USPTO indicates a total Applicant-delay period of 1,016 days. Of the total 1,016 days, 100 days are shown on PAIR to have been assessed on April 2, 2004, and 916 days are shown on PAIR to have been assessed on October 5, 2006. PAIR also indicates a PTO-delay period of 1,421 days. A printout from PAIR indicating the PTA determined as of June 10, 2009 is enclosed as Exhibit A.

3. A Restriction Requirement in the present application was mailed on September 24, 2003. The Restriction Requirement set a shortened statutory period for reply to expire one month from the mailing date of the Restriction Requirement.

4. A Response to the Restriction Requirement was timely filed by hand directly in the USPTO on October 20, 2003, as evidenced by a PTO-stamped receipt bearing the same date.

5. A Notice of Abandonment was mailed on March 15, 2004 indicating that no response to the September 24, 2003 Restriction Requirement had been received by the Patent Office.

6. A Request to Withdraw Erroneous Notice of Abandonment was filed on April 2, 2004 requesting that the Notice of Abandonment be withdrawn as erroneous and that the application be returned to pending status. The Request included a copy of the Response to Restriction Requirement and a copy of a return receipt postcard bearing the official USPTO date stamp confirming the USPTO's receipt of the Response on October 20, 2003.

7. On October 4, 2004, Applicants' undersigned attorney sent an email pursuant to 1282 O.G. 106 (18 May 2004), "Request for Alert Concerning Submitted Petitions", indicating that the Request filed April 2, 2004 had not yet been answered. A copy of this email is attached as Exhibit B.

8. Before filing an Information Disclosure Statement on May 16, 2005, it was again noticed that the USPTO had still failed to act on the Request to Withdraw Erroneous Notice of Abandonment. Accordingly, the Examiner for the present application was contacted telephonically in early April of 2005 to obtain a status of the Request.

9. The Examiner for the present application was contacted telephonically again on May 16, 2005 regarding the Request. The Examiner indicated that she had reviewed the file and had contacted the Office of Petitioners regarding the Request.

10. A Decision granting the Request was not mailed by the USPTO until June 19, 2006. In an apparent attempt to explain its delays, the Decision indicated that

although the Request was filed on April 2, 2004, the papers were received in the Office of Petitioners only at the time of writing the Decision.

11. An Information Disclosure Statement was filed on October 5, 2006, which is 916 days from April 2, 2004.

12. No terminal disclaimer has been filed in the present application.

ARGUMENTS

It is respectfully submitted that the USPTO incorrectly assessed an Applicant-delay period of 1016 days. The period of Applicant-delay is "equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application". 37 C.F.R. § 1.704(a). The 1,016 day period is believed to be incorrect because Applicants cannot identify any failures to engage in reasonable efforts to conclude prosecution during either the 100 day or 916 day periods of Applicant-delay shown on PAIR.

Regarding the 100 day period, it is believed that the USPTO incorrectly assessed days under 37 C.F.R. § 1.704(b) for failing to reply to the September 24, 2003 Restriction Requirement within three months. Applicants timely filed a Response to the Restriction Requirement on October 20, 2003, as corroborated by the Decision granting withdrawal of the erroneous Notice of Abandonment and the copy of the stamped return receipt postcard submitted with the Request. However, PAIR indicates that 100 days of Applicant-Delay were assessed for the period between December 24, 2003 and April 2, 2004, which is the filing date of the Request. Given that December 24, 2003 is three

months from the September 24, 2003 Restriction Requirement, it believed that the USPTO has erroneously treated the Request as a Response to the Restriction Requirement in calculating Applicant-delay. It is therefore respectfully submitted that the assessment of this 100 day period of Applicant-delay is in error.

It is also respectfully submitted that the USPTO incorrectly assessed an Applicant-delay period of 916 days for the period between the filing of the Information Disclosure Statement on October 5, 2006 and the filing of the Request on April 2, 2004. Applicants cannot identify any failures to engage in reasonable efforts to conclude prosecution during this 916 day period. The Notice of Abandonment was timely petitioned within the two months specified under 37 C.F.R. § 1.181(f). Although the Decision acknowledged that the Request was filed on April 2, 2004, the Decision indicated that the Request was not received in the Office of Petitioners until the time of writing the Decision. In addition, Applicants made inquiries on at least October 4, 2004, early April of 2005, and May 16, 2005 as to the status of the Request. Moreover, there was no delay associated with the filing of the Information Disclosure Statement on October 5, 2006. Accordingly, it is respectfully submitted that the assessment of the 916 day period of Applicant-delay is incorrect.

Thus, as set forth above, there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the present application as set forth in 37 C.F.R. § 1.704.

Since it is believed that Applicants engaged in reasonable efforts to conclude prosecution during the periods discussed above, the 1,016 days attributed to Applicant delay are believed to be in error.

RELIEF REQUESTED

In light of the foregoing, Applicants request reconsideration of the patent term adjustment, in which the Applicant-delay period of 1,016 days should be assessed as zero (0) days, and in which a determination of total patent term adjustment should be 1,421 days.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael K. O'Neill", is written over a horizontal line.

Michael K. O'Neill
Attorney for Applicants
Registration No.: 32,622

FITZPATRICK, CELLA, HARPER & SCINTO
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09/963,569 POWER CONVERTING APPARATUS AND POWER GENERATING APPARATUS

06-10-
2009::13:14:29**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 09/963,569

Filing or 371(c) Date:	09-27-2001	USPTO Delay (PTO) Delay (days):	1421
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	1016
Post-Issue Petitions (days):	+0	Total PTA (days):	405
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
05-12-2009	Mail Notice of Allowance		
04-28-2009	Document Verification		
05-12-2009	Notice of Allowance Data Verification Completed		
05-12-2009	Date Forwarded to Examiner		
04-13-2009	Supplemental Response		
04-28-2009	Case Docketed to Examiner in GAU		
03-11-2009	Information Disclosure Statement considered		
04-13-2009	Information Disclosure Statement considered		
04-13-2009	Information Disclosure Statement (IDS) Filed		
03-31-2009	Mail Examiner Interview Summary (PTOL - 413)		
03-26-2009	Examiner Interview Summary Record (PTOL - 413)		
03-11-2009	Electronic Information Disclosure Statement		
03-18-2009	Date Forwarded to Examiner		
03-18-2009	Date Forwarded to Examiner		
03-11-2009	Request for Continued Examination (RCE)		
03-18-2009	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
03-11-2009	Information Disclosure Statement (IDS) Filed		
03-11-2009	Workflow - Request for RCE - Begin		
12-11-2008	Mail Final Rejection (PTOL - 326)		
12-08-2008	Final Rejection		
09-28-2008	Date Forwarded to Examiner		
09-03-2008	Response after Non-Final Action		
06-03-2008	Mail Non-Final Rejection		
05-30-2008	Non-Final Rejection		
04-09-2008	Date Forwarded to Examiner		
02-19-2008	Response after Ex Parte Quayle Action		
01-28-2008	Mail Ex Parte Quayle Action (PTOL - 326)		
01-22-2008	Ex Parte Quayle Action		
11-15-2007	Date Forwarded to Examiner		
11-01-2007	Response to Election / Restriction Filed		
11-01-2007	Request for Extension of Time - Granted		
08-27-2007	Mail Restriction Requirement	1120	
08-20-2007	Requirement for Restriction / Election	↑	
07-19-2007	Date Forwarded to Examiner	↑	

04-02-2004	Response to Election / Restriction Filed	100
07-20-2007	Mail Notice of Rescinded Abandonment	↑
06-30-2006	Information Disclosure Statement considered	↑
06-30-2006	Information Disclosure Statement (IDS) Filed	↑
07-06-2007	Notice of Rescinded Abandonment in TCs	↑
10-05-2006	Information Disclosure Statement considered	↑
10-05-2006	Reference capture on IDS	↑
10-05-2006	Information Disclosure Statement (IDS) Filed	916
10-05-2006	Information Disclosure Statement (IDS) Filed	
07-13-2006	IFW TSS Processing by Tech Center Complete	
06-19-2006	Mail-Petition to Revive Application - Granted	
04-02-2004	Petition Entered	
05-16-2005	Reference capture on IDS	
05-16-2005	Information Disclosure Statement (IDS) Filed	
05-16-2005	Information Disclosure Statement (IDS) Filed	
03-15-2004	Mail Abandonment for Failure to Respond to Office Action	
03-08-2004	Abandonment for Failure to Respond to Office Action	
09-24-2003	Mail Restriction Requirement	301
09-22-2003	Requirement for Restriction / Election	↑
01-29-2003	Information Disclosure Statement (IDS) Filed	↑
01-29-2003	Information Disclosure Statement (IDS) Filed	↑
07-30-2002	Case Docketed to Examiner in GAU	↑
01-08-2002	Request for Foreign Priority (Priority Papers May Be Included)	↑
01-08-2002	Information Disclosure Statement (IDS) Filed	↑
01-08-2002	Information Disclosure Statement (IDS) Filed	↑
12-27-2001	Information Disclosure Statement (IDS) Filed	↑
12-27-2001	Information Disclosure Statement (IDS) Filed	↑
06-12-2002	Case Docketed to Examiner in GAU	↑
01-04-2002	Application Dispatched from OIPE	↑
01-04-2002	Application Is Now Complete	↑
10-26-2001	Notice Mailed--Application Incomplete--Filing Date Assigned	↑
10-24-2001	Correspondence Address Change	↑
10-02-2001	IFW Scan & PACR Auto Security Review	↑
09-27-2001	Initial Exam Team nn	↑

[Close Window](#)

O'Neill, Michael

From: O'Neill, Michael
Sent: Monday, October 04, 2004 10:28 AM
To: 'petitions@uspto.gov'
Subject: Petition Has Not Been Answered - sn 09/963,569

Sirs:

This is an e-mail sent pursuant to 1282 OG 106 (18 May 2004), "Request for Alert Concerning Submitted Petitions"

The following Petition has not been answered to date:

Application No. 09/963,569
Petition Filed April 2, 2004
37 CFR 1.181(a) - Withdraw Erroneous Abandonment For Failure To Respond To Office Action

Sincerely,
/Michael K. O'Neill/
Reg No. 32,622

cc: file 00862.022392

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